

REMARKS

An Office Action was mailed on November 6, 2003, and declared Final. Claims 1-18 are pending in the present application.

Claims 1-4, 6-9, 12 and 14-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over O'Halloran '883 in view of Baerlocher et al. '573, while claims 10, 11, 13 and 18 are further rejected under 35 U.S.C. §103(a) as being unpatentable over O'Halloran '883 in view of Baerlocher et al. '573 in further view of DeMar et al. '660. Responsive thereto, Applicants have amended all claims to recite that the prize outcomes of each prize set are displayed to the player prior to the player selecting a prize set. In addition, Applicants submit herewith an executed Declaration under 37 CFR 1.132 by one of the inventors, Edgar Pau.

In relation to the Examiner's comments in the Office Action in the Response to Arguments section commencing at page 7, we note that the Examiner does not agree that O'Halloran is equivalent to or at least a variant of a "double up feature" game. The Examiner's position is that because O'Halloran allows more than two selections, it can not be considered a variation of a double up game. However, as explained in Edgar Pau's Declaration (in particular paragraphs 5, 6 and 9), the key characteristic of a double up game is not that just two selections are allowed, but that there is a neutral effect on the overall return to the player.

We also note that in the middle paragraph of page 8 of the Response to Arguments, the Examiner states that O'Halloran does not provide a 100% theoretical return and does effect the calculation of the overall theoretical return to the player.

We also note that the Examiner submits that O'Halloran requires the player to qualify. Qualification for the bonus game of O'Halloran is routine and only requires a win in the underlying game. More importantly, as explained in the inventor's Declaration, O'Halloran does in fact teach a 100% theoretical return. This is explained in detail in paragraphs 5, 6 to 8 of Edgar Pau's Declaration.

We note that in the paragraph bridging pages 8 and 9 of the Office Action, the Examiner submits that the references (Baerlocher and O'Halloran) could be combined because "both inventions relate to the same field of invention specifically, electronic bonus gaming, wherein the over all theoretical return is clearly affected by the bonus game outcome". Whilst we do not

09/965,605
11176910 01

- 6 -

dispute that both inventions relate to the same field of invention, as is explained in Edgar Pau's Declaration in paragraphs 7 and 8, in O'Halloran the overall theoretical return is 100% and the effect of the bonus game of O'Halloran is neutral, whereas in Baerlocher, the overall theoretical return is clearly affected by the bonus game outcome. Therefore the Examiner's grounds for combining those two documents are invalid.

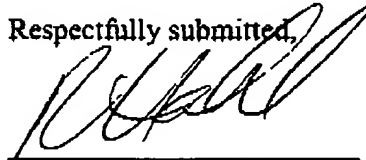
We also draw the Examiner's attention to paragraph 10 of the Pau Declaration, in which he explains why Baerlocher and O'Halloran are not readily combinable in the manner suggested by the Examiner because of the very different bonus game structures.

With regard to the middle paragraph of page 9, where the Examiner's comments in relation to allowing the player to view the prizes apparent on each wheel prior to selection - this feature, which the Examiner indicates is not taught by O'Halloran, is now recited in the independent claims.

In paragraph 11 of his Declaration, the inventor comments on the proposed amended claims and again identifies the features which distinguish over O'Halloran and Baerlocher. For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action. Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



Robert W. Hahl, Ph.D.
Reg. No. 33,893

CUSTOMER NUMBER 026304
PHONE: (212) 940-8708
FAX: (212) 894-5708 (direct)
DOCKET NO.: 3251/FBR (031035-87578)

09/905,605
11176910.01

- 7 -